



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/586,213	07/17/2006	Yukitane Kimoto	BAN-06-1206	2677

35811 7590 01/07/2010  
IP GROUP OF DLA PIPER LLP (US)  
ONE LIBERTY PLACE  
1650 MARKET ST, SUITE 4900  
PHILADELPHIA, PA 19103

EXAMINER
----------

BLACK, MELISSA ANN

ART UNIT	PAPER NUMBER
----------	--------------

3612

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

01/07/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

pto.phil@dlapiper.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/586,213	<b>Applicant(s)</b> KIMOTO ET AL.	
	<b>Examiner</b> MELISSA A. BLACK	<b>Art Unit</b> 3612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

Art Unit: 3612

### **DETAILED ACTION**

This is in response Amendments and remarks filed 10/2/09. Claims 1-23 are pending in the application and rejected as set forth below.

#### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, is it unclear how an FRP panel can be "wherein either of the first and second FRP layers is formed as a low-rigidity or low-strength or both FRP layer,...". What is meant by "or both FRP layer"? As written it sounds as though the claim is claiming that the FRP layers are formed as both FRP layer.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification fails to disclose what low rigidity and low strength are and therefore

Art Unit: 3612

will be interpreted as best understood. Is there a standard low rigidity or low strength. What is a low strength for an FRP material, since Fiber is used to reinforce the material.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1- 6, 9, 10, 13 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 2002-264846A.

Re Claim 1, JP 2002-264846A discloses an FRP panel for an automobile comprising a panel portion (1, 11, 31, 41, 51, 61, 71) having a first FRP layer (13) on a first surface side and a second FRP layer (14) on a second surface side on an opposite side of the first surface (See figures) wherein wither of the first and second FRP layers is formed as a low rigidity or low strength or **both FRP layer**, and the low rigidity or low strength or **both FRP layer** forms a crushable structure that absorbs impact. Re Claims 2, JP 2002-264846A discloses said panel element (1, 11) is an FRP solid plate which is formed integrally with said first FRP layer (13) and said second FRP layer (14). Re Claim 3, JP 2002-264846A discloses wherein said panel element (11) is a panel element which has a space (12) between said first FRP layer (13) and said second FRP layer (14). Re Claim 4, JP 2002-264846A discloses a core material is disposed in said space (12). Re Claim 23, JP 2002-264846A discloses a difference in planar rigidity against external force is provided between said first and second FRP layers by providing a difference in hardness between a surface and a back surface of said core material (see Paragraphs [0009] and

Art Unit: 3612

[0020]). Re Claim 5, JP 2002-264846A discloses a plurality of panel elements (13, 14) are provided, and a space is formed between adjacent panel elements (See Figures). Re Claim 6, JP 2002-264846A discloses a core material is disposed in said space (12). Re Claim 9, JP 2002-264846A discloses said difference in rigidity is provided by a condition where at least one surface of any one of said first and second FRP layers is formed as a surface having a concave/convex shape (See figures 5, 7-10). Re Claim 10, JP 2002-264846A discloses said surface having a concave/convex shape has a planar shape extending almost straightly (Figures 4 and 5). Re claim 13, JP 2002-264846A discloses wherein said concave/convex shape is provided along an outer circumferential shape of said FRP panel for an automobile (see figure 3).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Art Unit: 3612

9. Claims 7, 8 and 18-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2002-264846A.

JP 2002-264846A discloses the use of carbon-fiber for reinforcing the panels, but fails to disclose wherein said difference in rigidity and/or said difference in strength is provided by one or two or more differences selected from the group consisting of a difference in amount of reinforcing fibers, a difference in property of reinforcing fibers and a difference in orientation of reinforcing fibers, and wherein said difference in rigidity is provided by a condition where, with respect to a running direction of said automobile, a main orientation direction of reinforcing fibers of said first FRP layer is in a range of  $\pm 20^\circ$  relative to  $\pm 45^\circ$  disposition, and a main orientation direction of reinforcing fibers of said second FRP layer is in a range of  $\pm 20^\circ$  relative to  $0^\circ/90^\circ$  disposition. JP 2002-264846A further fails to disclose said difference in strength is provided by providing a high breaking elongation layer into any one of said first and second FRP layers; said high breaking elongation layer comprises a high breaking elongation resin, and said high breaking elongation resin comprises a thermoplastic resin having a low affinity in adhesion with a matrix resin of said FRP layer; high breaking elongation layer comprises a thermoplastic resin film, a multi-layer laminated film; wherein said difference in rigidity and/or said difference in strength is provided by providing a difference in thickness between said first and second FRP layers.

It would have been obvious to one with ordinary skill in the art at the time the invention was made to change the difference in rigidity or strength by changing the orientation of the fibers and/or putting more fibers in one panel over the other, for it is commonly known in the art of working with carbon fiber. The layers are usually laminated together and the fibers are laid at

Art Unit: 3612

different angles. As for the breaking elongation, it would have been obvious to one with ordinary skill in the art at the time the invention was made to for thermoplastic resins are well known in the art and changing the composition of them to strengthen or weaken them is well known in the art also, as for the material being laminated, it is common to laminate carbon fiber to strengthen the material. Furthermore these are mere design choices and require little to no skill in the art.

Applicant may seasonally challenge, for the official record in this application, this and any other statement of judicial notice in timely manner in response to this office action. Please specify the exact statement to be challenged. Applicant is reminded, with respect to the specific challenge put forth, of the duty of disclosure under Rule 56 to disclose material which is pertinent to patentability including claim rejections challenged by applicant.

10. Claims 11-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2002-264846A in view of US Pat # 7,150,496 to Fujimoto.

JP 2002-264846A fails to disclose the use a panel plane is sectioned in a lattice-like form into nearly rectangular areas by said concave/convex shape into nearly diamond-shaped areas by said concave/convex shape, and wherein said concave/convex shape is provided so as to depict a multiple closed curved line with a nearly concentric analog formation on a panel plane, wherein said concave/convex shape is provided along an outer circumferential shape of said FRP panel for an automobile, wherein said difference in strength is provided by introducing a plurality of discontinuous part of a reinforcing fiber substrate into at least one reinforcing fiber substrate layer of any one of said first and second FRP layers, wherein the discontinuous part extends almost straightly.

Art Unit: 3612

Fujimoto teaches the use a panel plane is sectioned in a lattice-like form into nearly rectangular areas by said concave/convex shape into nearly diamond-shaped areas by said concave/convex shape, and wherein said concave/convex shape is provided so as to depict a multiple closed curved line with a nearly concentric analog formation on a panel plane, wherein said concave/convex shape is provided along an outer circumferential shape of said FRP panel for an automobile, wherein said difference in strength is provided by introducing a plurality of discontinuous part of a reinforcing fiber substrate into at least one reinforcing fiber substrate layer of any one of said first and second FRP layers, wherein the discontinuous part extends almost straightly (See Figures 1-10).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to change the shape of the panel plane as taught by Fujimoto on the device of JP 2002-264846A in order to change the energy absorption of the panel during impact, furthermore changing the shape and/or size of an object is considered to be a design choice.

### ***Response to Arguments***

11. Applicant's arguments filed 2 October 2009 have been fully considered but they are not persuasive. Claims were broadly interpreted based on the claim language and applicants discloses. As described above under the 112 rejection the Claim language that was added describes the FRP layers as being low strength low rigidity or **both FRP layer**. JP 2002-264846A discloses that the first and second layers are both FRP layer, and therefore still read on the claims. Until further clarification of what the applicant is trying to claim, claims stand rejected as stated above.

### ***Conclusion***



Art Unit: 3612

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **MELISSA A. BLACK** whose telephone number is (571)272-4737. The examiner can normally be reached on M-F 7:00-3:30 ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Dayoan can be reached on (571) 272-6659. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3612

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. A. B./  
Examiner, Art Unit 3612

/Hilary Gutman/  
Primary Examiner, Art Unit 3612

/GLENN DAYOAN/  
Supervisory Patent Examiner, Art Unit 3612